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Phillip M. Weiss, Esq.
Weiss & Weiss
300 Old Country Road
Suite 251
Mineola, NY 11501

EXAMINER

CHAMPAGNE, DONALD

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| ART UNIT | PAPER NUMBER |
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3622

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05/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/801,167

Applicant(s)

GILLMAN ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 5 February 2007 have been fully considered but they are not persuasive. The arguments are addressed below at para. 6-7, 16-17 and 20.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following excerpts from claims 1 and 8 are indefinite: "said first person and said second person compete with each other professionally" (claim 1 lines 7-8) and "so that members in said networking groups do not compete with each other in business" (claim 8 lines 6-7). This rejection depends on the interpretation of the term "compete".
4. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". **An example does not constitute a "clear definition" beyond the scope of the example.**
5. The instant application contains no such clear definition for the phrase "compete". In the instant case, the examiner is required to give the term "compete" its broadest reasonable interpretation, which the examiner judges to be seeking to gain at the expense of others, said others being called competitors. The examiner believes that that is the plain meaning

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and would be readily recognized by one of ordinary skill in the art of competitive enterprise. The instant application does not disclose any objective standard for establishing who is in competition, so the term "compete" is indefinite (MPEP § 2171).

6. Applicant argues (pp. 4-6) that "compete" is clearly defined by the following disclosure:

"[0007] It is an object of the present invention to provide networking groups wherein professionals and businessmen are placed in a group so as not to compete in business with other professionals in the same networking group. For example, two doctors who are both orthopedic surgeons who work in the same area of a city, who may compete with each other for business, will not be placed in the same networking group." (Para. [0007] of the published spec., US 20020128905A1, emphasis added. This is also page 2, lines 5-9, of the spec. as filed.)

First, this disclosure is an example, which cannot clearly define anything beyond the scope of the example. Since the claims are not limited to orthopedic surgeons, this alleged definition is ineffective. Second, the example only discloses that said surgeons "may" compete. This leaves open the possibility that said two surgeons might not compete. Yet the definition says that said two surgeons "will not be placed in the same networking group." The spec. does not in fact provide any non-circular definition for "compete".

7. Applicant argues further, when addressing the examiner's hypothetical case of two salesman who work closely together:

"According to the definition established by the application, even if two car insurance salesman work for the same firm, they would not be placed in the same networking group. Since they are in the same profession in the same area location, it would not make sense to place these people in the same networking group according to the invention. The idea of the present invention is to have people make new contacts with non-competitive professions so that they can network and bring in more business. If the Examiner were correct about the two car insurance salesman, they would both be getting the same business which would not help the company that the car insurance salesman are working for. Instead if the car insurance salesman were in different networking groups, they would bring in two as many leads. Regarding the Examiner's example of the lawyers, although lawyers sometimes in practice and cooperate with each other, the ideas of the invention is to place lawyers of different practices in the

same group and lawyers who are practicing the same businesses in different groups.

This is not taught by the prior art." (Page 6, middle para., emphasis added.)

By the accepted definition (para. 5 above), the two hypothetical salesmen cooperate, and do not compete. They also are in the same profession and the same area of practice. Hence, the claimed invention does not require that they be placed in different databases/networking groups. However, applicant argues that they would have to be placed in different groups because it would serve their business interests to do so. The argument has moved away from competition to applicant's opinion as to how best to bring in business. This hardly constitutes the objective definition required by 35 USC 112, first para. (MPEP § 2171).

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for other limitations, does not reasonably provide enablement for selecting persons based on whether or not they compete. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. No standard is disclosed for selecting persons based on whether or not they compete. See para. 2-5 above.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (US 20020194049A1) in view of Romano ("Meet me in Cyberspace", *Association Management*, September 1998).

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12. Boyd teaches (independent claim 1) a method for providing online networking groups, the method comprising: registering three or more users by asking them to store information in *user profile database 213* (para. [0064] and [0085-0086]), which reads on entering a profile and a second profile (and a third profile) into a computer database, and creating a networking group (all three or more users/members) contained within said computer database; and a first user forming and posting an invitation to a networking meeting to two or more other users ([0049 and 0024]), the *selection preferences and criteria* including that the attendees be *intellectual property attorneys* ([0031]), the invitation being placed in *invitation database 211*, which reads on comparing said profile and said second profile (comparing both user profiles to the *selection preferences and criteria*)¹, moving said second profile into a second database (*invitation database 211*) is said second profile and said second profile contain same professions and same areas of practice (*intellectual property attorneys*), and creating a network group (the invited members) contained within said second database (*invitation database 211*).
13. Boyd does not teach networking/meeting online. Romano teaches networking/meeting online (Abstract). Because Romano teaches that this enables networking when members lack the opportunity to interact face-to-face (Abstract), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Romano to those of Boyd.
14. Neither reference teaches that said first person and said person compete with each other. That is, neither reference teaches that said first person and said person are put in different networking groups when they compete with each other. Because it would be counterproductive to be put competitors into a single networking group, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd and Romano that competitors be placed in different networking groups.
15. The entire purpose of professional networking is to enhance one's business, by finding sales prospects for example, or identifying cheaper ways to do business. One of ordinary skill in the art would readily understand that a person "A" would not tell a competitor "B" such things. It would be counterproductive, because, by definition, competitor "B" would use such knowledge to undercut the business of person "A".

¹ Things compared to the same thing are compared to each other.

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16. Applicant argues, (para. at the top of p. 8),

"Boyd specifically gives as examples people in the same profession networking together. Neither of the two prior art references cited by the Examiner teach placing person's who compete or may compete with each other in a different networking group. In fact, according to the present invention if two persons were working in the same company in the same profession, they would be placed in separate networking groups, however, the Examiner has stated that according to Boyd these people would be put into the same networking group. Therefore, Claims 1-8 cannot be anticipated or obvious over Boyd and Romano. Based on the definition cited above for 'compete', neither Boyd nor Romano teach this nor make it obvious."

In fact, applicant claims three criteria for separating persons into different groups: "moving said second profile into a second database if said profile and said second profile (1) contain same professions and (2) same areas of practice, and (3) said first person and said second person compete with each other professionally". (Claim 1, lines 6-8, numbers in parentheses added.) As has been noted above (para. 2-7), there is no definition for "compete" given in the spec. Rather, applicant is presuming that people in "the same profession" and "the same area of practice" are in competition. Yet the examiner has given a hypothetical case where this is not true (para. 7 above).

The rejection logic is straightforward: it is obvious to separate people according to their interests. Applicant has attempted to simplify this into three criteria, but the three criteria are subjective and not internally consistent. (People in the "same professions" and "same areas of practice" may or may not be in competition; see para. 7 above.)

17. Applicant also argues,

"Some networking groups allow competitive professions within a networking group and such is taught by Boyd. Therefore, separating competitive professionals cannot be obvious in the prior art." (Fourth para. from the top of p. 8.)

Applicant misrepresents the reference. It is acknowledged (para. 12 above) that Boyd teaches the two profiles containing people with the "same professions and same areas of practice". Boyd neither teaches nor suggests that these people are in competition.

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18. Boyd also teaches at the citations given above claim 2 (where the invitation reads on a referral). Boyd also teaches claims 5 ([0073]) and 7 ([0065-0066]).
19. Neither reference teaches (claims 3 and 4) rewards or positive incentives commensurate with the number of invitations/referrals provided by a user. However, Boyd does teach negative incentives for a user who does not make invitations or violate invitation rules ([0053, 0073-0075 and 0111]). Because the system would work only if user make as well as honor invitations, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Boyd rewards or positive incentives commensurate with the number of invitations/referrals provided by a user.
20. Applicant argues,

“There are many professional networking groups out there that do not discuss incentives for referrals. In fact, Boyd only discusses negative rewards. Therefore, it cannot be obvious to have the incentives described in the present application. Therefore, Claims 3 and 4 are not obvious over the prior art.” (Fourth para. from the top of p. 8.)

Applicant argument is *non sequitur*. Just because “many” do not discuss incentives does not mean that none do. As to negative incentives implying positive incentives, applicant fails to address the justification in the rejection (para. 19).
21. Neither reference teaches (claim 6) communicating online via video/audio conferencing. However, Boyd does teach a system with video monitors and cameras ([0094 and 0101]). Because Boyd teaches that the purpose of the reference invention is to make the best use of a user’s time ([0006]), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add meeting by video/audio conferencing to the teachings of Boyd and Romano.
22. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyd (US 20020194049A1) in view of Romano (“Meet me in Cyberspace”, *Association Management*, September 1998), for the reasons given above in para. 12 and 13. The limitation “so that members in said networking groups do not compete with each other in business” was not given patentable weight because it does not structurally limit the invention. To be patentable, apparatus or system inventions must be structurally distinguishable from the

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prior art (MPEP § 2114). The subject limitation adds no structure, so it cannot help make the claim 8 apparatus/system invention patentable.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
26. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
28. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when

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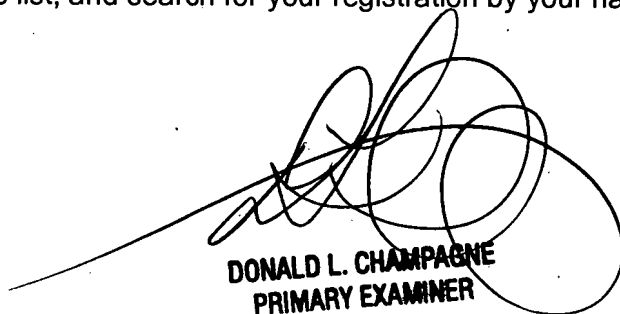
applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

29. Applicant may have after final arguments considered and amendments entered by filing an RCE.

30. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

10 May 2007



DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622